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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/802,883	03/12/2001	Leo I. Rainer	00-240	5679

7590 02/26/2003
William S. Bernheim
255 N. Lincoln St.
Dixon, CA 95620

EXAMINER

CIRIC, LJILJANA V

ART UNIT	PAPER NUMBER
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3743

DATE MAILED: 02/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/802,883

Applicant(s)
Rainer et al.

Examiner
Ljiljana V. Ciric *LVC*

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Dec 4, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above, claim(s) 2-6, 8-11, 13, 15, and 17-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 7, 12, 14, and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Mar 12, 2001 is/are a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

Election/Restriction

1. Applicant's election without traverse of the first species or the embodiment described on page 6, lines 20-28 (readable on claims 1, 7, 12, 14, and 16) in Papers No. 5 and 7 is acknowledged.

NOTE: In Paper No. 5, applicant elects the first species or the embodiment described on page 6, lines 20-28. In Paper No. 7, applicant indicates that claims 1, 5, 6, 7, 12, 14, and 16 are readable on the elected species. Applicant makes no mention is made of claim 2, either as being readable on the elected species or as being withdrawn from further consideration. The examiner has determined claim 2 as being readable on the non-elected second species or the embodiment described on page 7, lines 4-9; claim 2 is hereby withdrawn from further consideration as being drawn to a non-elected invention. Also, contrary to applicant's assertion, the examiner finds claims 5 and 6 to also be readable only on non-elected inventions or species. In particular, claim 5 is drawn to the non-elected fourth species or the embodiment described on page 7, lines 13-15, whereas claim 6 is drawn to the non-elected fifth species or the embodiment described on page 7, lines 16-17. Each of claims 5 and 6 is thus also hereby withdrawn from further consideration.

2. Thus, claims 2 through 6, 8 through 11, 13, 15, and 17 through 24 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention,

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there being no allowable generic or linking claim. Election was made without traverse in Papers No. 5 and 7.

Information Disclosure Statement

3. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered. The examiner has cited the references listed on pages 3 and 4 of the specification on the attached form PTO-892, and has thus considered the same. A separate information disclosure statement thus need not be filed by applicant for these same references.

Drawings

4. The drawings filed on March 12, 2001 are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the following features must be shown or the feature(s) canceled from the claim(s): the damper having first and second positions as recited in claim 1; an indoor temperature sensor as recited in claim 1; a microprocessor which is included by the controller as recited in claim 1; a building interior as recited in claim 1; and, a compressor-based air conditioner condensing unit and evaporator coil as recited in claim 16. No new matter should be entered.

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A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to because the buttons which are part of the wall display unit 1 should be assigned a separate reference number since the buttons are specifically recited in claim

1. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

6. The abstract of the disclosure is objected to because the transitional term “consisting” appearing in line 1 of the abstract has an overly limiting meaning not consistent with the disclosure and should be replaced with the term “comprising” or similar for improved consistency with the remainder of the disclosure. Also, “During summer” should be replaced with “During the summer,” and “During winter” should be replaced with “During the winter,” for improved grammatical correctness. Correction is required. See MPEP § 608.01(b).

7. The use of the trademark “AirCycler” on page 4, for example, has been noted in this application. All occurrences of this trademark and any others appearing in the disclosure of the instant application should be capitalized and be accompanied by the corresponding generic terminology.

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Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Objections

8. Claims 1, 7, 12, 14, and 16 are objected to because of the following informalities: each claim should end with a period (.) and not with a semi-colon (;). Appropriate correction is required.

Claim Rejections - 35 U.S.C. § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1, 7, 12, 14, and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 7, 12, 14, and 16 appear to claim both an apparatus (“A system for using outside ventilation”) and a process of using the apparatus (i.e., “said air delivery means *supplies* outside air to a building interior” and “said damper means *directs* airflow from said air delivery means using a first and second position”) and are therefore indefinite for failing to positively recite the metes and bounds of protection. Recommend converting the process steps to either proper means-plus-function limitations or to corresponding intended use limitations.

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The term "similar" in claim 1, line 8 is a relative term which renders the claim indefinite. The term "similar" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Thus, as used to describe the volume of indoor air released to outdoors, this term renders the volume of air and the claims indefinite.

With regard to the claims, applicant is reminded that a claim limitation is to be interpreted invoking 35 U.S.C. 112, sixth paragraph *only* if the claim limitation uses the phrase "means for" or "step for" modified with functional language only, and not by structure, material or acts for achieving the specified function. In claim 1, for example, applicant appears to attempt to invoke interpretation according to 35 U.S.C. 112, sixth paragraph by citing the limitations "an air delivery means, damper means, sensor means, and control means" in line 2 of the claim. Claim 1 also recites the limitation "communication means". None of these limitations, however, use the phrase "means for" and therefore are being interpreted broadly and not as invoking 35 U.S.C. 112, sixth paragraph. *Cf. Seal-Flex, Inc. v. Athletic Track and Court Construction*, 172 F.3d 836, 849-50, 50 USPQ2d 1225, 1233-34 (Fed. Cir. 1999). Also *Cf. Morris*, 127 F.3d at 1055, 44 USPQ2d at 1028. Also *Cf. Rodime PLC v. Seagate Technology, Inc.*, 174 F.3d at 524, 531, 41 USPQ2d 1429, 1435-36 (Fed. Cir. 1999).

The above is an indicative, but not necessarily an exhaustive, list of 35 U.S.C. 112, second paragraph, problems. Applicant is therefore advised to carefully review all of the claims for

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additional problems. Correction is required of all of the 35 U.S.C. 112, second paragraph problems, whether or not these were particularly pointed out above.

Claim Rejections - 35 U.S.C. § 101

11. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

12. Claims 1, 7, 12, 14, and 16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Whereas 35 U.S.C. 101 permits claims to be drawn to either a process or to machine *in the alternative*, the claims appear to recite both a ventilation system (i.e., “A system for using outside ventilation...”) and process steps for operating the same (i.e., “said air delivery means *supplies* outside air to a building interior regulated by said control means”, “said damper means *directs* airflow from said air delivery means using a first and second position, wherein said damper first position *causes* said air delivery means to recirculate indoor air, and said damper second position *causes* said air delivery means to supply outside air to indoor spaces and to release a similar volume of indoor air to outdoors”, “said algorithms *calculate* a ventilation limit temperature which is greater than or equal to said minimum temperature setting and which *increases* with decreasing building cooling requirements to prevent over-cooling”, and, “said control means *initiates* said ventilation cooling operation *by activating* said air delivery means and *by changing* position of said damper means to said second position when the temperature sensed by said indoor sensor exceeds the temperature sensed by

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said outdoor sensor by a predetermined magnitude, and *terminates* said ventilation cooling operation when the temperature sensed by said indoor sensor falls below said ventilation limit temperature”).

Claim Rejections - 35 U.S.C. § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. As best can be understood in view of the indefiniteness of the claims, claims 1, 7, 12, 14, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by *Han* ('125).

Han ('125) discloses a ventilation system essentially as claimed, including: a temperature conditioning system 10 which read on the air delivery means as recited in the claims of the instant invention; damper means or economizer damper 27 having first and second positions; an indoor sensor 36 and an outdoor sensor 28 which read on the sensor means as recited in the claims of the instant invention; a control means including a digital keypad/display 34 which reads on the user interface including buttons or keys; a controller as depicted schematically in Figure 2 including a microprocessor or I/O processor 42; heating elements 14 which read broadly on the heating coil as recited in claim 12; a condensing unit or condenser 18; and, an evaporator 20. Little or no patentable weight is given to functional language and process steps recited in the apparatus claims.

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The reference thus reads on the claims.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. *Hile, Han et al., Kobayashi et al., Rayburn et al., and Gross et al.* each discloses a building ventilation system with damper controls.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ljiljana (Lil) V. Ciric, whose telephone number is (703) 308-3925. While she works a flexible schedule that varies from day to day and from week to week, Examiner Ciric may generally be reached at the Office during the work week between the hours of 10 a.m. and 6 p.m. ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett, can be reached on (703) 308-0101. The fax phone number is (703) 305-3463.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0861.

lvc

February 22, 2003



LJILJANA V. CIRIC
PRIMARY EXAMINER
ART UNIT 3743